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Supreme Court of the United States.

OCTOBER TERM, 1963.

No. 960.

HAROLD E. MARASCO AND MARASCO SHOE MACHINERY COMPANY, INCORPORATED,
Petitioners,

v.

COMPO SHOE MACHINERY CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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35 U.S.C. § 102(a), (b)	2

Patents 1,160,983 and 2,058,446. This finding did not include non-obviousness over either the prior art Malverdi patent or the prior art Ghini machine, issues which were not reached, because each of these items of prior art was held to anticipate all four claims. 35 U.S.C., Section 102 (a) and (b).

A prior art Ghini machine was introduced in evidence as Defendant's Exhibit P (Record, vol. I, p. 171), and Appendix A to this brief is an excerpt from the chart prepared from the Ghini machine by defendant's expert, Dr. Harrington. This chart, introduced in evidence as Defendant's Exhibit MM, shows wherein all of the elements of claims 2 and 3 of the patent in suit or their equivalents are found in the Ghini machine. Similar charts covering anticipation of claims 1 and 4 by Ghini and all claims by the Malverdi patent were introduced in evidence as Defendant's Exhibits LL and NN (Record, vol. I, pp. 219-229).

Thus this is an ordinary patent case where we have concurrent findings of the lower Courts that the patent is anticipated by the Malverdi patent and the Ghini machine.

Petitioners did Not Prove Commercial Success.

Contrary to the implications from the statements at the top of page 6 of the petition, petitioners' pad box of the patent in suit was such a complete commercial failure that in February of 1962 they placed on the market their "Model C" pad box, which is shown and described at pages 19-23 of volume III of the Record and which is not covered by the patent in suit.

Unlike the pad box of the patent in suit, respondent's pad box uses removable rubber heel wedges 31 which have different thicknesses and different shapes to accommodate different types and heights of heels (Record, vol. II, p.

273, col. 2, lines 10-13). There is no evidence whatever proving that the very limited commercial acceptance of respondent's pad box was due to the purported invention of the patent in suit rather than to (*a*) respondent's improvements, (*b*) the adoption by United States shoe manufacturers of the unpatented tableless process commencing in 1958 and (*c*) respondent's advertising. Hence petitioners have failed to prove any commercial success due to the pad box disclosed in their patent. *M'Clain v. Ortmayer*, 141 U.S. 419, 428.

In any event, "commercial success without invention will not make patentability." *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 153.

There is no evidence to support the statement at page 6 of the petition that the pad box arrangement of Malverdi "achieved no success." Evans, Inc., bought a Ghini machine from the Italian manufacturer early in 1958 and used it commercially in its factory from May, 1958, until it was shipped to Boston for the trial of this case on June 8, 1962 (Record, vol. I, pp. 167-176). There is no evidence proving that Ghini machines were not used with equal satisfaction in Europe and by others in the United States.

The petitioners are seeking to have this Court find and consider purported facts which were not found by either of the lower Courts—facts which are not established by the evidence in this case.

The Petition should be Denied.

The case at bar does not present any conflict between Courts of Appeals as to validity of a patent such as would warrant granting of the petition. *Layne & Bowler Corporation v. Western Well Works, Inc.*, 261 U.S. 387, 393. Indeed, there was not even a conflict between the District Court and the Court of Appeals.

Petitioners are seeking to have this Court review evidence and discuss facts on an ordinary finding by the District Court of invalidity for anticipation, which finding was affirmed by the Court of Appeals. This Court consistently refuses to grant a writ in such a situation. *Layne & Bowler Corporation* v. *Western Well Works, Inc.* (*supra*). *Kelley* v. *Adams-Campbell Co.*, 264 U.S. 314, 319. *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U.S. 175, 177-179.

Conclusion.

The petition discloses no reason for disturbing the judgment of the Court of Appeals affirming the judgment of the District Court. There is no decision of any other Court of Appeals or of this Court which is in conflict with the decision of the Court of Appeals herein. This case turns upon petitioners' misconstruction of the opinions below and upon their failure to present evidence in support of the statements of purported facts found in the petition. We respectfully submit that there is no such special or important issue as to justify the granting of a petition for a writ of certiorari herein. We ask that the petition be denied.

Respectfully submitted,

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Appendix A.

CHART SHOWING WHEREIN
ALL OF THE ELEMENTS OF CLAIMS 2 AND 3 OF MARASCO PATENT 2,962,736
OR THEIR EQUIVALENTS ARE FOUND IN THE MALVERDI MACHINE.

ELEMENT NUMBER	ELEMENTS OF CLAIM 2	IS ELEMENT OR ITS EQUIVALENT FOUND IN MALVERDI?
Introd.	A two-part pad box for sole presses, comprising	
2	complementary box sections as complete units, being bolted together and each having	YES — Malverdi's box sections are held in removable relationship to one another by his articulated linkage while performing the sole attaching function so his linkage is equivalent.
(a)	a fluid pressure inlet and	YES
(b)	a separate flexible pad,	YES
2	the pad of one section having a flat sole engaging portion and a heel-lea[illegible] portion disposed at substantially right angles thereto and	YES
3	the pad of the other section having an upright portion engaging the rear curved surface of a heel attached to the shoe bottom.	YES
	ELEMENTS OF CLAIM 3	
Introd.	A press for heel-attached shoe bottoms, having	
1	Complementary forepart and rear pad box sections as complete units containing	YES
2	separate flexible pads with vertical portions for engaging opposite faces of an interposed heel, and	YES
3	means for positively holding the two sections against longitudinal displacement	YES

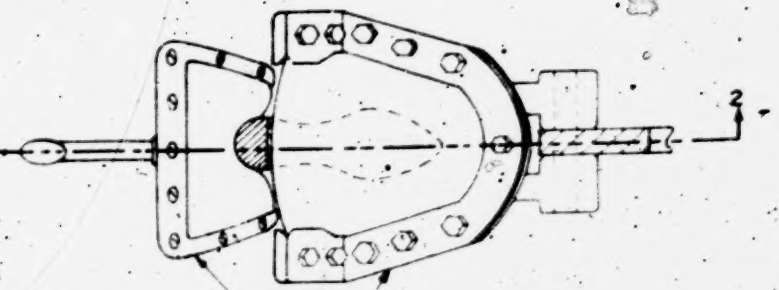

FIG 1

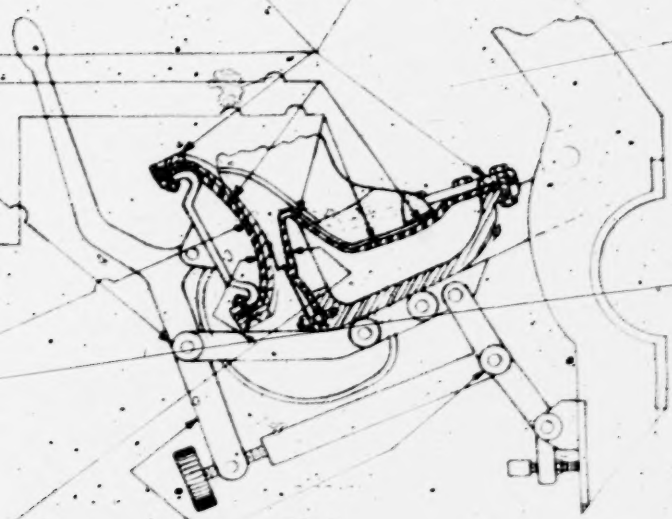

FIG 2

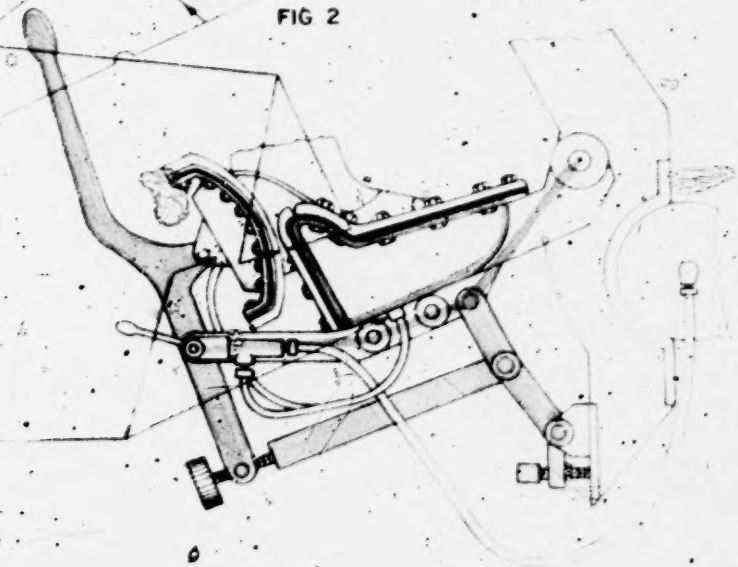

FIG 3